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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,595	02/05/2004	George Bokisa	TASKP104US	5184

23623 7590 03/01/2006

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EXAMINER

WONG, EDNA

ART UNIT	PAPER NUMBER
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1753

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/772,595

Applicant(s)

BOKISA ET AL.

Examiner

Edna Wong

Art Unit

1753

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 15 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

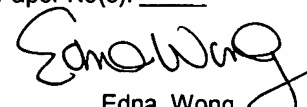
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-13 and 15-26.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See pages 2-10.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

  
Edna Wong  
Primary Examiner  
Art Unit: 1753

***ADVISORY ACTION***

This is in response to the Amendment dated February 15, 2006. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Response to Arguments***

**Claim Objections**

Claim **15** has been objected to because of minor informalities.

The objection of claim 15 has been withdrawn in view of Applicants' amendment.

**Claim Rejections - 35 USC § 112**

Claim **6** has been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection of claim 6 under 35 U.S.C. 112, second paragraph, has been withdrawn in view of Applicants' amendment.

**Claim Rejections - 35 USC § 103**

I. Claims **1-6, 8 and 24** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **JP 10-245693** ('693) in combination with **Passal** (US Patent No. 3,697,391).

The rejection of claims 1-6, 8 and 24 under 35 U.S.C. 103(a) as being unpatentable over JP 10-245693 ('693) in combination with Passal is as applied in the Office Action dated October 13, 2005 and incorporated herein. The rejection has been maintained for the following reasons:

Applicants state that since the main purpose of JP '693 is to improve the bonding of Ni alloys to an insulator, one skilled in the art would not have modified JP '693 by using a compound such as a brightener that would DECREASE the resultant Ni alloys ability to bond to an insulator by increasing its matte or grainy surface. In other words, one skilled in the art would NOT have frustrated the purpose of JP '693 by including an additive that would impede the bonding between its plated alloy and substrate.

In response, the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by the Applicants. *In re Linter* 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Dillon* 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), *cert. denied*, 500 US 904 (1991); and MPEP § 2144.

Passal teaches the equivalency of N-heterocyclics and acetylenics as primary brighteners (col. 3 , lines 3-6). Thus, the substitution of an N-heterocyclic with an acetylenic would have performed the same function in a nickel alloy electroplating environment.

Furthermore, it has been held that the selection of a known material based on its

suitability for its intended use supports a prima facie obviousness determination. See MPEP § 2144.06 and § 2144.07.

Applicants state that changing the brightener in JP '693 would undermine and vitiate the basic teachings of JP '693, and render its disclosed discovery impotent.

In response, objective evidence must be factually supported by an appropriate affidavit or declaration to be of a probative value (MPEP § 716.01(c) and § 2145).

Applicants state that one skilled in the art would NOT have replaced the quaternary ammonium salt brightener of JP '693 with the acetylenic brightener of Passal because there is NO teaching or suggestion in Passal indicating that its acetylenic brighteners would be effective for improving the appearance of quaternary Ni-Co-M1-M2 alloys (wherein M1 and M2 are two alloy metals). That is, there is NO teaching or suggestion in Passal indicating that its acetylenic brighteners cause the uniform placement of additional metals within the matrix of a Ni-Co alloy.

In response, there is no requirement that the motivation to make the combination be expressly articulated in one or more of the references. The teaching, suggestion or inference can be found not only in the references but also from knowledge generally available to one of ordinary skill in the art. *Ashland Oil v. Delta Resins* 227 USPQ 657 (CAFC 1985). The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin* 170

USPQ 209 (CCPA 19710; *In re Rosselet* 146 USPQ 183 (CCPA 1960). References are evaluated by what they collectively suggest to one versed in the art, rather than by their specific disclosures. *In re Simon* 174 USPQ 114 (CCPA 1972); *In re Richman* 165 USPQ 509, 514 (CCPA 1970).

Applicants state that in order to support the Examiner's combination, the Examiner cites functions (1) to (4) of Column 3 of Passal attributable to the primary brighteners, secondary brighteners, and secondary auxiliary brighteners. However, this contention is based only on impermissible hindsight, made with the guidance of the instant specification.

In response, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge (i.e., Passal's Column 3 teachings) which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicants state that Passal fails to teach or suggest which specific beneficial functions (1) to (4) are enabled by the specifically listed primary brighteners, secondary brighteners, and secondary auxiliary brighteners. Moreover, Passal fails to teach or suggest which specific beneficial functions (1) to (4) are enabled by acetylenic

brighteners.

In response, Passal teaches that examples of a primary brightener are 2-butyne-1,4-diol, bis- $\beta$ -hydroxyethyl ether of 2-butyne-1,4-diol, propargyl alcohol, and 2-methyl-3-butyne-2-ol (col. 3, lines 3-23). These acetylenic brighteners are listed in Applicants' claims 24/1 and 25/9.

Passal's failure to teach or suggest which specific beneficial functions (1) to (4) are enabled by the acetylenic brighteners does not distinguish the method from the prior art because the same compounds would have reasonably been expected to have the same properties or functions.

Claim 18 recites "at least two brighteners selected from the group consisting of sulfur containing brighteners and acetylenic brighteners. Claim 18 does not require acetylenic brighteners because the claim reads on just selecting two sulfur containing brighteners.

Applicants state that in the absence of a specific teaching regarding the ability of acetylenic brighteners to improve the appearance of quaternary Ni-Co-M1-M2 alloys, one skilled in the art would NOT have replaced the quaternary ammonium salt brightener of JP '693 with the acetylenic brightener of Passal.

In response, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the

references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Applicants state that since the salt brighteners of JP '693 contribute to the conductivity of its electroplating bath, one skilled in the art would NOT change the conductivity of JP '693 electroplating bath by substituting an acetylenic brightener for its quaternary ammonium salt brighteners. Thus, for this additional reason, there would be NO motivation for one skilled in the art to employ an acetylenic brightener in JP '693.

In response, Passal teaches that among the second auxiliary brighteners include ions or compounds of certain metals and metalloids such as zinc, cadmium, selenium, etc., which although they are not generally used at present, have been used to augment deposit luster, etc. (col. 4, lines 24-23-27). The metal and metalloid ions would have contributed to the conductivity of the electroplating bath.

Applicants state that even if combined, neither JP '693 nor Passal teach or suggest quaternary Ni-Co alloys.

In response, JP '693 teaches or suggests quaternary Ni-Co alloys (page 1, [0007]). The prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. V. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. Denied*, 469 U.S. 851 (1984). In addition, a known or obvious composition does not



become patentable simply because it has been described as somewhat inferior to some other product for the same use, see *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994). Further, a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments, see *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), *cert. denied*, 493 U.S. 975 (1989). See MPEP § 2141.02, MPEP 2145X.D.1 and MPEP § 2123.

Passal has been used in the rejection to teach the acetylenic brighteners.

II. Claim 7 has been rejected under 35 U.S.C. 103(a) as being unpatentable **JP 10-245693** ('693) in combination with **Passal** (US Patent No. 3,697,391) as applied to claims 1-6, 8 and 24 above, and further in view of **Hui** (US Patent No. 6,372,118 B2).

The rejection of claim 7 under 35 U.S.C. 103(a) as being unpatentable JP 10-245693 ('693) in combination with Passal as applied to claims 1-6, 8 and 24 above, and further in view of Hui is as applied in the Office Action dated October 13, 2005 and incorporated herein. The rejection has been maintained for the reasons as discussed above.

III. Claims **9-12, 15-17 and 25** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **JP 10-245693** ('693) in combination with **Passal** (US Patent No. 3,697,391).

The rejection of claims 9-12, 15-17 and 25 under 35 U.S.C. 103(a) as being unpatentable over JP 10-245693 ('693) in combination with Passal is as applied in the Office Action dated October 13, 2005 and incorporated herein. The rejection has been maintained for the reasons as discussed above.

**IV.** Claim 13 has been rejected under 35 U.S.C. 103(a) as being unpatentable over **JP 10-245693** ('693) in combination with **Passal** (US Patent No. 3,697,391) as applied to claims 9-12, 15-17 and 25 above, and further in view of **SU 1544847** ('847).

The rejection of claim 13 under 35 U.S.C. 103(a) as being unpatentable over JP 10-245693 ('693) in combination with Passal as applied to claims 9-12, 15-17 and 25 above, and further in view of SU 1544847 ('847) is as applied in the Office Action dated October 13, 2005 and incorporated herein. The rejection has been maintained for the reasons as discussed above.

**V.** Claims **18-23 and 26** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **JP 10-245693** ('693) in combination with **Passal** (US Patent No. 3,697,391).

The rejection of claims 18-23 and 26 under 35 U.S.C. 103(a) as being unpatentable over JP 10-245693 ('693) in combination with Passal is as applied in the Office Action dated October 13, 2005 and incorporated herein. The rejection has been maintained for the reasons as discussed above.

With regards to claim 22, Applicants state that Passal does not teach or suggest adding a conductivity salt to an electroplating bath.

In response, Passal teaches maintaining pH during plating at pH values of 2.5 to 5.0 with boric acid (col. 7, line 74 to col. 8, line 8). Boric acid is listed in Applicants' claims 23/22. It has been held that a newly discovered use or function of components does not necessarily mean the system is unobvious since this use or function may be inherent in the prior art. *Ex parte Pfeiffer* 135 USPQ 31.

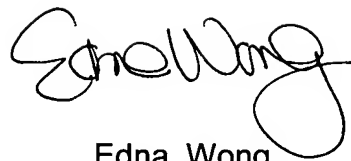
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edna Wong whose telephone number is (571) 272-1349. The examiner can normally be reached on Mon-Fri 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/772,595  
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A handwritten signature in black ink, appearing to read "Edna Wong". The signature is fluid and cursive, with the first name "Edna" and last name "Wong" clearly distinguishable.

Edna Wong  
Primary Examiner  
Art Unit 1753

EW  
February 24, 2006